INDEX

	PAGE
OPINIONS BELOW	1
JURISDICTION	3
QUESTIONS PRESENTED	3
STATUTES INVOLVED	3
STATEMENT OF THE CASE	3
ARGUMENT	4
"Reasons for Granting the Writ and Argument"	4
"The Questions Raised in This Petition Have Not Been Decided by the Supreme Court"	4
"The Questions Presented by this Petition Are of Great Public Importance"	6
"The Decisions Below Depart From the Traditional Standards of Invention"	6
"The Judiciary Has Not and Cannot Change the Standard of Invention"	9
CONCLUSION	11

CITATIONS

Cuno Engineering Corp. v. *Automatic Devices Corp.*, 314 U. S. 84	2, 10
Goodyear Tire & Rubber Co. v. *Ray-O-Vac Co.*, 321 U. S. 275	10
Great Atlantic & Pacific Tea Company v. *Supermarket Equiment Corporation*, 340 U. S. 147	2, 10
Picard v. *United Aircraft Corporation*, 128 F. (2d) 632 (2nd Cir.)	5

IN THE

Supreme Court of the United States

OCTOBER TERM, 1952

No. 144

CARPENTER CONTAINER CORPORATION,
Petitioner,

v.

THE CONTAINER COMPANY,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF FOR RESPONDENT IN OPPOSITION.

Opinions Below.

The opinion of the District Court (P.D.A.-136a)* is reported at 99 F. Supp. 167. The opinion of the Circuit Court of Appeals for the Third Circuit (C.R.P.C.A.-127) affirming the District Court is reported at 194 F. (2d) 1013.

* Abbreviations used:
P.D.A.—designates Petitioner Defendant's Appendix.
R.D.A.—designates Respondent Plaintiff's Appendix.
C.R.P.C.A.—designates Certified Record of Proceedings in Court of Appeals.

We do not agree with Petitioner's interpretation of the opinions below. First, Petitioner contends that the "specific claimed combination of the Carpenter patent was new". Judge Rodney's opinion, which was affirmed by the Court of Appeals, states that

> "An examination of the prior art patents shows clearly that the combination of these elements, considered in their broadest terms, did not constitute a new or novel combination at the time of the Carpenter application." (P.D.A.-142a)

and that "the exact combination of the elements *in all the details claimed*"* was not in any single prior art patent (P.D.A.-143a). The italicized portion of the above quotation is important because the opinions below found that the claims in suit were for a three-element combination of a body, a cover, and a split ring and that this combination was disclosed in several prior art patents. The claims differed from the prior art only in the specific "details claimed" but not as combinations. The lower courts found that these details were not sufficient to lend patentability in view of the prior art.

Secondly, the opinions below found that the claims did not "constitute patentable invention over the prior art". While the courts below, as stated in the petition, made reference to "the strict standards laid down by the Supreme Court" in previous cases, such as *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, and *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, there is nothing in the opinions below to indicate that the courts would have arrived at a different conclusion under what Petitioner calls the traditional standard of invention, whatever that may be.

---

* All emphasis ours unless otherwise stated.

Therefore we disagree with Petitioner's statement (p. 3) that the opinions of the courts below are concerned with the present standard of invention required to sustain the validity of a patent. It is believed to be clear from the opinions below that the claims in suit are invalid under any standard of invention. Further reasons for this statement are given in our discussion (*infra*, p. 5) under the topic "The Decisions Below Depart From the Traditional Standards of Invention".

Jurisdiction.

The jurisdictional requisites are adequately set forth in the petition.

Questions Presented.

We submit that the only question presented by this case is whether or not the claims in suit are patentable in view of the prior art. We are unable to agree with Petitioner's statement of the questions presented.

Statutes Involved.

We have no comment on this portion of the petition.

Statement of the Case.

This is an action involving the validity of the Carpenter patent No. 2,382,858 for Container. The patent was held invalid "as not disclosing any patentable invention over the disclosure of the prior art" (P.D.A.-144a). The lower courts also held that the patent was for an old combination and that "improvement in one or more of the old elements, such as the clamping ring, does not make the old combination repatentable as such" (P.D.A.-144a).

The Findings of Fact (P.D.A.-146a to 148a) on which these holdings are based, are adequately supported by the evidence and Petitioner has not shown any of the Findings to be erroneous. Petitioner's Statement of the Case is inaccurate for the reasons set forth in our discussion of the Opinions Below (*supra*, p. 2).

No conflict with any other decision is involved either as to the patent in suit or as to a question of law.

Argument.

No sound reason for granting this petition has been advanced by Petitioner. We will discuss the points raised by Petitioner under the headings used in the petition.

"Reasons for Granting the Writ and Argument."

Under this heading Petitioner's argument is directed to two questions: First, that the questions raised in this petition have not been decided by the Supreme Court and, second, the questions are of great public importance. Neither of these statements is correct.

"The Questions Raised in This Petition Have Not Been Decided by the Supreme Court."

We have difficulty in comprehending Petitioner's argument on this point. Apparently Petitioner is under the impression that somewhere in the Constitution, or the patent statutes, or in decisions by this Court, there is some kind of a fixed standard of invention which Petitioner refers to as "the traditional standard of invention" or as "the standard established by the U. S. Constitution as traditionally interpreted and understood".

We know of no traditional standard of invention as stated in the Constitution, the patent statutes, or in any

decision by the Supreme Court of the United States. What constitutes invention in any given case has always been a matter of opinion of the Court to which the question was presented. Invention is impossible of fixed definition and can be determined in any given case by consideration of a multitude of factors peculiar to the particular case. In view of this, there is no such thing as a "Constitutional standard" (Petition, p. 3), nor is there any such thing as "the standard established by the U. S. Constitution as traditionally interpreted and understood" (Petition, p. 3).

Under this heading Petitioner also refers to decisions of certain lower courts indicating that such courts believe that the United States Supreme Court as presently constituted has laid down a higher or stricter standard of invention than that required heretofore and then proceeds to challenge the power of the Court "to thus modify *the Patent Laws* by requiring a stricter standard of invention" (Petition, p. 11).

We are unable to understand the relevancy of Petitioner's argument as to the belief by the lower courts that a higher standard of invention has been established by this Court. This question might be relevant in the present case if it appeared that the courts below would have held the claims in suit to be patentable under the mythical, "traditional standard of invention", but that these claims would be unpatentable solely because of some higher standard said to be required by this Court. Even then there would be no occasion for a writ of certiorari because if this Court has set a higher standard of invention it is the duty of the lower courts to accept the decisions of this Court as they understand such decisions as was well stated by Judge Learned Hand of the Second Circuit Court of Appeals in *Picard* v. *United Aircraft Corporation,* 128 F. 2d 632, 636, quoted by Petitioner (p. 8).

The petition (p. 11) requests a clarification by this Court of its views on the standard of invention, that is

to say, whether or not the standard has been raised, and a decision by the Court as to whether the judiciary has the power to *modify the patent laws* by requiring a stricter standard of invention. We submit that there is no occasion for a decision by the Court on either of these points and that these questions are not really presented in the present case.

"The Questions Presented by this Petition Are of Great Public Importance"

Petitioner's argument under this heading boils down to the proposition that each patent owner would like to know whether or not his patent is valid. This has been the situation ever since the first patent was granted and will continue until the last patent expires. Whether the Carpenter patent in this suit is valid is of no importance to other patent owners. Therefore, a decision by this Court on that patent would not be an answer to the question as to whether or not all other patents are valid. Petitioner is asking for the impossible and the argument under this heading does not, in our opinion, merit serious consideration.

"The Decisions Below Depart from the Traditional Standards of Invention"

Under this heading Petitioner sets up six items, the existence of which is supposed to indicate the presence of invention.

The first (p. 13) is *"Invention resides in a new combination producing new and improved results"*. This item does not apply to the claims of the patent in suit because these claims are not for a new combination. Judge Rodney in his Finding of Fact 6 (P.D.A.-147a), speaking of the claims in suit, states:

> "Each of these claims calls for the three element combination of a body, a head and a split clamping ring.

> • • • Each of the claims in suit is for a complete container structure employing the said three elements."

In Finding 7 (P.D.A.-147a) he states:

> "Many of the prior art patents in evidence disclose the same three element combination of a body, head and split clamping ring as that of the claims in suit".

He then lists eight U. S. patents disclosing this exact combination. These Findings of the trial court clearly show that the patent in suit does not respond to Petitioner's item 1 of the "Traditional Standards of Invention".

The second item (p. 13) is *"Invention is indicated where a patent makes a substantial contribution to the art"*. There is no evidence that the features of the claims in suit made any substantial contribution to the art. As a matter of fact, Judge Rodney in Finding 9 (P.D.A.-148) stated:

> "Insofar as the features of the claims in suit are concerned, the Grinden structure is the same as that of the Carpenter patent in suit".

Grinden was a patent long prior to Carpenter, thus showing that there was nothing in the claims in suit which made any substantial contribution over and above that which was prior to Carpenter.

The third item is *"The normal presumption of validity is reinforced by the administrative determination of the Patent Office."* There is nothing in this case to indicate that the normal presumption of validity was reinforced by anything which happened in the Patent Office sufficiently to overcome the disclosures of the prior art patents.

The fourth item (p. 14) is *"Invention is evidenced by a long lapse of time between the date of the prior art patents and the date of the invention and* (in) *issue."* This is an incomplete statement. We know of no decision which sup-

ports this item as so broadly stated by Petitioner. The long lapse of time in order to have any significance must be accompanied by the solution of a problem that existed throughout this long period of time and must be accompanied by the further fact that when the problem was solved the art abandoned the old and went to the new. There is not a word of evidence in this case that any of these things was in the present case. As a matter of fact, as we have shown above in connection with Petitioner's item 2, the Grinden patent which issued in April 1918, some twenty-seven years prior to the issuance of the Carpenter patent, "is the same as that of the Carpenter patent in suit" (Finding 9, P.D.A.-148a) insofar as the features of the claims are concerned. In view of this Finding, we are unable to see how the lapse of time can be of any comfort or assistance to Petitioner.

The fifth item (p. 14) is *"Invention is proven by the commercial success."* Obviously, this statement is incorrect. We know of no decision by the Supreme Court which says that commercial success alone proves invention. It is the established law of the land that commercial success can be considered only when invention is in doubt and that under certain circumstances it might turn the scale in favor of invention. In the present case, commercial success was not proved. There is not a word of evidence in the case to show that the structure of the claims enjoyed any commercial success and of course there was nothing to show that any feature of any claim in suit made any contribution to any commercial success of the claimed structure.

The sixth item (p. 14) is *"Invention is evidenced by an infringer's imitation."* There is no evidence in this case and no finding by the trial court that the accused structures were imitations of the claimed structures. In fact this would be impossible in view of Judge Rodney's Finding 7 (P.D.A.-147a) that insofar as the features of the

claims in suit are concerned, "the Grinden structure is the same as that of the Carpenter patent in suit".

From the foregoing it is evident that based upon the Findings of Fact of the trial court, affirmed by the Court of Appeals, the claims in suit in the present case do not meet a single requirement which Respondent has set up as necessary to the traditional standard of invention. Under these circumstances, so far as the present case is concerned, it is apparent that it makes no difference whatever whether or not this Court has set up a higher or stricter standard of invention than that which Petitioner chooses to call the traditional standard of invention. The claims in suit are invalid as measured by any standard which has ever been set up by this Court.

"The Judiciary Has Not and Cannot Change the Standard of Invention"

We are unable to understand Petitioner's argument under this heading for the very simple reason which we have already stated, namely, that what constitutes invention in any given case is a matter of opinion of the Court before whom the question is presented. Furthermore, there never has been and probably never will be any fixed standard or yardstick by which the presence or absence of invention can be determined in all cases. Whether or not invention exists in a given case depends upon numerous factors, which factors are never the same in any two cases. Petitioner's argument seems to be that the present Court would be changing the patent statutes or the Constitution of the United States if it expressed an opinion as to the presence or absence of invention which differed from the mythical and non-existent "traditional standard of invention".

Obviously Petitioner does not think that this Court has changed the standard of invention from that of long ago

because it states (p. 16) that "This traditional standard of invention was apparently recognized by the Supreme Court as recently as *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 88 L. Ed. 271." In that case, the patent in suit was held valid and infringed, but in the *Great Atlantic & Pacific Tea Company* v. *Supermarket Corporation* (*supra*), this Court held the patent there in suit invalid. Since the *A. & P.* case is subsequent to *Ray-O-Vac* case, we presume that Petitioner feels that this Court departed from the "traditional standard" in the *A. & P.* case.

Judge Rodney in his opinion (P.D.A.-141a), stated:

> "To the extent that the combinations claimed in these claims may be merely combinations of old elements, it is clear that to be patentable, they must demonstrate something new and useful, either in the result or the method of its achievement. Marconi Wireless Co. v. United States, 320 U. S. 1, A. & P. Tea Co. v. Supermarket, 340 U. S. 147."

He then went on to find that the combinations claimed were the same as disclosed in the Grinden patent, as we have previously shown by the quotation from his Findings 6 and 7. This is the standard which has always been used for combination claims. Evidently Petitioner feels that the standard of invention was raised by this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, was lowered in *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, and was raised again in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.*, 340 U. S. 147. We believe that the action of this Court in the *Cuno* case where the patent was held invalid for lack of invention, in the *Ray-O-Vac* case where the patent was held valid and infringed, and in the *A. & P.* case where the patent was held invalid for lack of invention, shows that this Court has followed the same pattern as the Su-

preme Court of the United States has followed throughout its history, namely, that whether or not invention is present in a given case depends upon the particular facts of that case and that it is not determined by some fixed standard or yardstick, traditional or otherwise. The present case presents no problems that would be of general interest and therefore there is no occasion for the granting of the petition since the trial court came to the conclusion that the claims in suit were invalid in view of the prior art and was affirmed in this Finding by the Third Circuit Court of Appeals.

CONCLUSION.

For the foregoing reasons it is submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

NEWTON A. BURGESS,
Counsel for Respondent.

EUGENE G. MASON,
H. H. HAMILTON,
JOHN J. MAHONEY,
of Counsel.

Dated: July 23, 1952.